

REMARKS

This application has been reviewed in light of the Office Action dated December 23, 2009. Claims 34-66 are presented for examination, of which Claims 34, 46-59, 54-60 and 64-66 are in independent form. The independent claims, and Claim 35, have been amended to define still more clearly what Applicant regards as his invention. Favorable reconsideration is requested.

The Interview

Initially, Applicant thanks the Examiner for conducting a telephonic interview with his undersigned attorney on March 8, 2010. During that interview Applicant's attorney reviewed what Applicant is claiming, and argued against the Examiner's combination of prior-art references. The substance of what was argued is repeated below, with the addition of further arguments in support of patentability.

The Prior-Art Rejection

Claims 49, 50, 52-60 and 62-66 were rejected under 35 U.S.C. § 103(a) as being obvious from U.S. Patent 6,215,523 (Anderson et al.) in view of U.S. Patent 6,441,854 (Fellegara et al.), U.S. Patent Application Publication 2002/0032677 (Morgenthaler), U.S. Patent 6,680,749 (Anderson et al.) and U.S. Patent 6,549,304 (Dow et al.). Claim 51 was rejected under Section 103(a) as being obvious from those documents in view of U.S. Patent 6,657,702 (Chui et al.), Claims 34-40, 44-48 and 61, as being obvious from *Anderson '749* in view of *Dow*, *Anderson '523*, *Fellegara* and *Morgenthaler*, Claim 41, as being obvious from those five documents in view of U.S. Patent 5,752,053

(Takakura et al.), and Claims 42 and 43, as being obvious from the same five documents in view of *Chui*.

The Claimed Invention

The aspects of the present invention to which the claims are directed provide the user with the ability to view plural reduction images (in Claim 34, for example, "a first display control unit adapted to cause a display device to display the reduction images"), to select those that appear to be of interest ("a reduction image selection unit adapted to select a second plurality of reduction images from among the reduction images displayed by said first display control unit"), then, by means of an automatic and sequential display, to review the selected ones at a larger size that is still less than full size ("a second display control unit adapted to effect, in a size larger than that of the reduction image, automatic sequential display of images corresponding to the stored images which correspond respectively to the second plurality of reduction images selected"), and from these larger ones to select one or more actually to undergo whatever processing the user may intend ("a designating unit adapted to designate at least one image among the second plurality of images displayed ... in the size larger than that of the reduction image, as an image to be subjected later to a specific image process"). Such processing might be, for example, to e-mail the finally-selected images to a particular recipient, to store them in a particular memory, or to subject them to image processing of a type that would actually change the image content in some way; the exact nature of the processing is not material, and what the present invention provides is the ability for the user to make the selection in two steps, making an initial "cut" or selection using smaller reduction images, and then

making a final “cut” or selection viewing larger reduction images from among those selected in the first selection.

As was explained during the interview, the aspects of the present invention to which the present independent claims are directed provide the user with the ability to view plural reduction images, to select those that appear to be of interest, then to view the selected ones at a larger size that is still less than full size, and from these larger ones to select one or more actually to undergo whatever processing the user may intend. Such processing might be, for example, to e-mail the finally-selected images to a particular recipient, to store them in a particular memory, or to subject them to image processing of a type that would actually change the image content in some way. The exact nature of the processing is not material, and that what the claimed apparatus and methods provide is the ability for the user to make the selection in two steps, making an initial “cut” or selection using smaller reduction images, and then making a final “cut” or selection viewing larger reduction images from among those selected in the first selection. (As shown above, and as was kindly suggested by the Examiner, the claims have been amended to make clearer that the first selection is made from a plurality of reduction images, and that the second selection is made from a plurality of images that were chosen in the first selection.)

The Prior-Art References

Anderson allows a user to view a thumbnail image and, with it, plural smaller thumbnails of the same image, modified according to each of plural processings (Figs. 13 - 15). Even if one processing is ultimately chosen to be applied to a given image, or to several images, it appears to be done manually, one image at a time, and a selected image does not seem to be shown in a larger version then. *Anderson* does not suggest a

two-stage selection process, or showing a selected reduction image in a larger reduction-image size, or designating a group of images for processing as a group.

Anderson II allows a user to view several thumbnails at a time, and to select one for editing or other processing (in review mode); the user can also see the selected thumbnail in a larger format as 704 in Fig. 8. (This is similar to prior art described in Applicant's Background section.) There is no suggestion of a second "cut"; moreover, the user has to select each enlarged thumbnail for processing, individually, and cannot select a group; nor is there any suggestion of instructing a processing for an entire group of images.

Fellegara allows a user to review all images in a memory card, or all images in camera's memory, one at a time; this can be done either manually, or as a slide show. If a slide show is used, the display begins with the last image made by the camera; alternatively, the user can select an image from a list, and that image is used as the starting point for the slide show (it is not even clear from *Fellegara* whether, in such a case, only the images from the selected one on back to the oldest are displayed in the slide show, or whether thereafter the newer images are also shown automatically until all the images have been shown). *Fellegara* says nothing about what the user is to do while viewing this slide show; additionally, there is no suggestion of using two sizes of thumbnails, or of a two-stage selection process, or of a way to designate a group of images to be processed as a group.

*The Combination of References Relied Upon
in the Office Action Is Improperly Based on Hindsight*

Applicant acknowledges that the Office may properly formulate an obviousness rejection by, in some sense, reconstructing what is in the prior-art references. Nonetheless, there is a limit to this, and the Examiner is respectfully reminded that it is impermissible to pick and choose elements from the prior art and combine them in a way *guided only by an applicant's own disclosure*:

"Applicants may argue that the examiner's conclusion of obviousness is based on improper hindsight reasoning. However, '[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but *so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure*, such a reconstruction is proper.' *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). [Emphases added.]" MPEP § 2145. X.

Applicant submits that the present rejections of the independent claims herein are textbook examples of improper hindsight reconstruction. To obtain the structures recited in the independent claims (we shall take the rejection of Claim 34 as an example) using the prior art relied upon in the Office Action, the Examiner begins with features of the *Anderson* device illustrated in Fig. 13, where the device shows a first image (not numbered) and, above it, a line 852 of smaller modifications of that same image, each of which shows the result that is obtained upon subjecting the first image to respective types of processing. *Anderson* provides for the user to scroll through the line 852 of modified images, and to instruct that the original image is to be subjected to one of the available types of processings. In *Dow* the Examiner states that he finds the recited storing unit of Claim 34, or more precisely the "a storing unit adapted to continue, at least up to completion of the automatic and sequential display with the larger size by said second display control unit, to

store information indicating the at least one image designated by said designating unit as the image to be subjected later to the specific image process", although the cited portion of *Dow* appears to deal entirely with a description of various types of editing modules 78 - 96 that permit a user of the *Dow* system to edit pages of documents, including fax pages and e-mail. Indeed, it is noted that after listing the available modules, the portion of *Dow* upon which the rejection relies - apparently for module 88, although the Office Action is not clear on this - states:

"Initialization module 76 contains the boot software that is invoked when appliance 22 powers up. This module works closely with operating system 68 and device drivers 72 to perform any hardware initialization for processor 62, memory devices 64, display 24, and software initialization for global resources, such as message queues and buffers, system tasks, and memory partitions. Capture page module 78 controls the acquisition of images through photoelement array 52 and their conversion into a suitable format for storage in memory 64. Thumbnail view module 82 provides the default visual for pages and icons shown on display 24. For example, FIGS. 8A and 8B show a memory usage indicator icon for the cases where memory 64 is empty (i.e., no captured pages in memory) and where memory 64 holds 25 captured pages. In FIG. 8C, thumbnail view module 82 presents an entire captured page on display 24. Zoom view module 84 allows the user to magnify a portion of a page as illustrated in FIG. 8D. Page rotation module 86 allows the user to rotate a page either in thumbnail or zoom view in 90° increments. *Attach page module 88 allows the user to logically join pages together to form a group of pages that can be manipulated as an individual unit.* Conversely, detach page module 92 allows the user to separate a page or pages from a previously formed group. Delete page module 94 allows the user to purge a page or group of pages from memory 64. Send page module 96 allows the user to transfer a page or group of pages to another appliance, device or system through the serial or IR communication ports of appliance 22. Error utility module 98 provides notification to the user when the user attempts an invalid operation. Help utility module 102 provides the user, in real time, with general instructions through text and animation for operating appliance 22 and context sensitive instructions for performing a specific operation. The operation of help utility module 102 will be discussed in detail hereinafter. Lastly, menu/navigation interface module 104 provides the user with graphical menus for performing various operations and processes the user's response thereto. Moreover, menu/navigation interface module 104 responds to navigation buttons 42, 44, 46, and 48 that allow the user to steer a course through the graphical menus and view the stored pages. [Emphasis added.]" Col. 6, lines 22-63.

The only disclosure here concerning module 88 is a statement that that module enables a user to make a logical connection of two or more *pages* - that is, this module is part of a system for handling fax, e-mail and similar *documents*. It is not at all seen why a person of merely ordinary skill in the art would even consider using anything in *Dow* in attempting to improve the *Anderson* device. Applicant submits that the Office has failed to provide any reason such person would choose, from all the discussion in *Dow* relating to the handling of *documents*, simply a cursory mention of a single software module relating to coupling pages. In fact, the only such reason in the record is Applicant's own disclosure, upon which the Office cannot properly rely as a template to piece together a rejection.

Anderson II is cited for disclosure of a slide show display of a series of images. Again, the Office Action does not really explain why a person of ordinary skill would be interested in incorporating a slide show display into the *Anderson* device. Even if it be granted for argument's sake that the proposed combination of *Dow* and *Anderson* were somehow proper (and it is not), there is no reason provided as to why a person of ordinary skill would add a slide show display to *Anderson* in precisely the way necessary to obtain the structure recited in Applicant's claims. On the contrary, since the only series of images mentioned in *Anderson* seems to be the modified images in series 852, and *Anderson* does discuss the user scrolling through those images (col. 13, lines 17-20), it seems to Applicant that such a person would be far more likely to add a slide show feature to the viewing of that series 852 of images. There is no other series of images to in the *Anderson* system to which it could be applied. To suggest that a slide show display be used to modify the *Anderson* device in some other way does not seem to be explainable except as improper hindsight based entirely on Applicant's own disclosure.

Fellegara, in turn, is cited for providing a sequential display of images larger than previously viewed thumbnail images (col. 14, lines 20-55). Again, the only series of images to which such an idea might be applied is the series of modified images 852. Absent Applicant's own disclosure, there is nothing identified in the Office Action that could possibly guide a person of ordinary skill to use the *Fellegara* feature any other way in the *Anderson* device.

Morgenthaler is cited as teaching a system in which a user may select an image seen in a slide show, and then access the image directly (paragraph [0056]). This teaching, however, also fails to provide any reason - other than from Applicant's own disclosure - to have thought of using a slide show display to view enlarged images in the *Anderson* device.

The foregoing is believed to demonstrate clearly that the present rejections of Claim 34, and each of the other independent claims, is based entirely on improper and arbitrary selection of basically unrelated bits and pieces of disparate references, using Applicant's own disclosure as a guide. The rejections under Section 103, therefore, are believed to be improper, and their withdrawal is respectfully requested.

*The Proposed Combination of the Prior-Art References
Is Improper Because It Would Render the Modified
Prior Art Inoperable for Its Intended Purpose*

In addition, a proposed modification of a primary reference that would result in the device of that reference being rendered unusable, is impermissible:

"If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (Claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet

for the blood were located at the bottom end of the filter assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were *prima facie* obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.).” MPEP § 2141.01.

As pointed out above, the *Anderson* device is intended to allow a user to choose one type of distorting process to an original image (col. 13, lines 10-22). The user sees multiple such distortions at once - four, in the example shown in Fig. 13 - and can see a larger number by scrolling through the distorted thumbnails 852. The user chooses one, which is then actually applied to the full-size original image, which can then be printed or saved (col. 13, lines 18-22). To operate in the intended manner, thus, the *Anderson* device must at the least be able to display its series 852 of distorted thumbnails, and to allow the user to navigate through them to select one of them. If instead a series of thumbnails of *different* original images were displayed, the device could not operate in the manner described in that document. The same is true, only more so, if all the various changes to *Anderson* that would be needed to obtain what is recited in any of the independent claim, were made. For this reason, as well, Applicant submits that the obviousness rejections of the independent claims are improper and should be withdrawn.

*The Proposed Combination - Even If It Were Proper -
Would Still Fail to Teach All the Features of Claim 34*

Even if it would have been obvious for a person skilled in the art to combine *Anderson*, *Anderson II* and *Fellegara* to attain a slide show of images which a user has selected from displayed reduction images, the Examiner's combination still fails to teach or suggest the recited designating unit, which designates a plurality of images to be subjected later to a specific image process, from among the images displayed in the slide show, and the recited storing unit, which continues, at least during the slide show, to store information of the plurality of images designated during the slide show as the images to be subjected later to the specific image process.

Even if *Dow* also is combined with those three references, the resulting combination of four references would still merely teach a structure that displays a slide show of images which the user has selected from displayed reduction images, and forms a page group by logically joining a plurality of pages together as an individual unit which can be manipulated (see col. 6, lines 41-43 of *Dow*: "Attach page module 88 allows the user to logically join pages together to form a group of pages that can be manipulated as an individual unit"). The combination of the above-described four references does not teach or suggest the recited designating unit, which designates the plurality of images to be subjected later to the specific image process, from among the images displayed in the slide show, and also does not teach or suggest the storing unit, which continues, at least until the slide show ends, to store the information of the plurality of images designated during the slide show as the images to be subjected later to the specific image process.

Therefore, even the proposed combination of *Anderson*, *Anderson II*, *Fellegara* and *Dow* (even assuming that the combination were not impermissibly based on

hindsight reconstruction that relies largely if not entirely on using Applicant's own disclosure and claims as a guide) does not teach or suggest the structures recited in the claims, as even if combined they cannot teach or suggest an apparatus having the storing unit and the designation unit, operating together as recited in that claim.

Further, even assuming for argument's sake that it would have been obvious for a person skilled in the art to display a slide show of images which a user has selected from displayed reduction images, and even if *Morgenthaler* as well as *Dow* is combined with *Anderson*, *Anderson II*, and *Fellegara* the resulting combination merely leads to a structure that displays a slide show of images selected by the user from displayed reduction images, forms a page group by logically joining the plurality of pages together as an individual unit which can be manipulated (in accordance with *Dow*), and, when an image displayed in the slide show is clicked by the user, activates a browser to access a corresponding web site (lines 22-26 of paragraph [0056] of *Morgenthaler*: "With selection of a desired graphical file viewed in the slideshow, end users may then click on the image to bring up another browser providing direct access to the corresponding web site and server"). However, even that structure fails to teach or suggest continuing, at least until the slide show ends, to store information of the web sites corresponding to the plurality of images clicked during the slide show display thereof. In addition, even if the combination teaches bringing up the browser to access the web site, it still fails to teach or suggest designating, during the slide show, the images to be subjected, after completion of the slide show, to a specific image process.

That is, even if the proposed combination of *Anderson*, *Anderson II*, *Fellegara*, *Dow* and *Morgenthaler* were actually within the grasp of a person of ordinary skill who did not also have Applicant's disclosure as a guide, the result of that combination

would not, and could not, teach or suggest the designating unit and storing unit of Claim 34 and the other independent apparatus claims (or the corresponding steps of the method and memory-medium claims), which together function as clearly recited in that claim and as discussed above.

Independent Claim 49, while broader than Claim 34 in certain respects, recites elements needed to provide an apparatus that can operate to give the user the ability to make a two-stage selection as described above with regard to Claim 34. It is believed that the foregoing arguments apply to the rejection of Claim 49 with equal force, and that that rejection should be withdrawn for the same reasons.

Each other independent claim corresponds in substance to one or the other of Claims 34 and 49, and is believed to be allowable for the same reasons.

A review of the other art of record has failed to reveal anything which, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration or reconsideration, as the case may be, of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

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